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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,281	03/29/2001	James E. Hanson	YOR920000580US1	4457
7590	06/30/2004		EXAMINER THOMPSON JR, FOREST	
Duke W. Yee Carstens, Yee & Cahoon, LLP P.O. Box 802334 Dallas, TX 75380			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,281

Applicant(s)

HANSON ET AL.

Examiner

Forest Thompson Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-132 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-132 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-132 have been examined.

Claim Objections

2. Claims 29, 73 and 117 are objected to because of the following informalities: In lines 1-2, the claims recite "are be placed" in lines 1-2. For the purpose of expeditious prosecution, examiner has assumed that the intended claim language should be "are to be placed" in lines 1-2, and examined the claims in this context. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-21, 30-33, 62-65, 74-77, 106-109, and 118-121 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18-21, 62-65, and 106-109 each recite the limitation "the criteria" in line

1. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Claims 30-33, 74-77, and 118-121 each recite the limitation "the requested category " in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10, 11-13, 15-17, 22-27, 29, 34-57, 59-61, 66-71, 73, 78-102, 103-105, 110-115, 117, 122-132 are rejected under 35 U.S.C. 102(e) as being anticipated by Conklin et al. (U.S. Patent No. 6,141,653).

Claims 1, 45, 89: Conklin et al. teaches:

- registering, by a matchmaker, with at least one of a plurality of directory services (col. 17 lines 14-34);
- receiving, at a matchmaker, advertisements from a plurality of vendor agents (fig. 1g [50]),
- the plurality of vendor agents obtained the identity and contact information of the matchmaker from the at least one of a plurality of directory services (col. 17 lines 14-34);
- the advertisements comprise an informational format designated by the matchmaker (col. 27 line 35 – col. 28 line 36);

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- obtaining, by a consumer agent, the identity and the contact information about the matchmaker from the at least one directory service (col. 17 lines 14-34) as inferred by the use of the Internet by the matchmaker;
- receiving, at the consumer agent, a consumer agent selected list of advertisements from the matchmaker, wherein the each advertisement in the selected list of advertisements match criteria specified by the consumer agent (col. 13 lines 12-41);
- sending, from the consumer agent, a request for a quote to one or more of the vendor agents corresponding to advertisements in the consumer agent selected list of advertisements (col. 20 lines 24-34); and
- receiving, by the consumer agent, responses from the one or more vendor agents (col. 19 lines 15-57).

Claims 2, 37, 46, 81, 90, 125: Conklin et al. teaches completing a purchase of a product from a selected one of the one or more vendor agents replying with an offer for sale (col. 19 line 14 – col. 24 line 41).

Claims 3, 47, 92: Conklin et al. teaches the consumer agent selected list of advertisements is provided to the consumer agent for a fee (col. 24 lines 45-63).

Claims 4, 48, 92: Conklin et al. teaches the fee includes a subscription fee to the matchmaker service (col. 24 lines 45-63).

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Claims 5, 49, 93: Conklin et al. teaches the fee includes a fee per list of advertisements provided to the consumer agent by the matchmaker (col. 24 lines 45-63), which is encompassed by the teaching of a one-time service for a fee.

Claims 6, 50, 94: Conklin et al. teaches the matchmaker charges a fee to each of the plurality of vendor agents for listing the advertisements with the matchmaker service (col. 24 lines 45-63), which is encompassed by the teaching of *the present invention could be operated as a one-time service for a fee as well as an ongoing systems. In either case, the costs of the system's fees are likely to be dwarfed by the costs the users would otherwise have incurred if they had to create their own Websites and mechanisms.*

Claims 7, 51, 95: Conklin et al. teaches the fee includes a subscription fee (col. 24 lines 45-63).

Claims 8, 52, 96: Conklin et al. teaches the fee includes a fee per advertisement listed with the matchmaker (col. 24 lines 45-63).

Claims 9, 53, 97: Conklin et al. teaches:

- listing a matchmaking service with one or more of a plurality of directory services, wherein each of the plurality of directory services contains contact information for matchmaking services (col. 17 lines 14-34);
- receiving and carrying advertisements from one or more vendor agents (col. 30 lines 13-20),

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- the one or more vendor agents locate the matchmaking service using the one or more of a plurality of directory services with which the matchmaking service is listed (col. 17 lines 14-34);
- the advertisements conform to a format dictated by the matchmaking service (col. 27 line 35 – col. 28 line 36); and
- responsive to a request from a consumer agent, providing a consumer agent with vendor information (col. 19 lines 15-57).

Claims 10, 54, 98: Conklin et al. teaches organizing the advertisements into categories (col. 30 lines 9-20).

Claims 11, 55, 99: Conklin et al. teaches the vendor information includes vendors listings (col. 30 lines 9-20).

Claims 12, 56, 100: Conklin et al. teaches the vendor information includes information about available products (col. 14 line 66 – col. 15 line 6).

Claims 13, 57, 101: Conklin et al. teaches the available products include goods (col. 15 lines 14-17).

Claims 15, 59, 103: Conklin et al. teaches the vendor information includes contact information for vendors (fig. 9 [605, 610, 615]).

Claims 16, 60, 104: Conklin et al. teaches the contact information is provided for a fee (col. 24 lines 58-63), as encompassed by the teaching *the present invention could be operated as a one-time service for a fee.*

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Claims 17, 61, 105: Conklin et al. teaches the vendor information includes a list of advertisements matching criteria supplied by the consumer (col. 13 lines 12-41).

Claims 22, 66, 110: Conklin et al. teaches a fee is charged to the consumer agent for providing the list of advertisements sent to the consumer agent (col. 24 lines 45-63).

Claims 23, 67, 111: Conklin et al. teaches the fee includes a subscription fee to the matchmaker service (col. 24 lines 45-63).

Claims 24, 68, 112: Conklin et al. teaches the fee includes a fee per list provided by the matchmaker (col. 24 lines 45-63).

Claims 25, 69, 113: Conklin et al. teaches a fee is charged to the vendor agents for carrying the advertisements (Abstract).

Claims 26, 70, 114: Conklin et al. teaches the fee includes a subscription fee (col. 24 lines 45-63).

Claims 27, 71, 115: Conklin et al. teaches the fee includes a fee per advertisement listed with the matchmaker (col. 24 lines 45-63).

Claims 29, 73, 117: Conklin et al. teaches some of the advertisements are to be placed in a position of prominence within a category list in response to receipt of a payment of a premium fee (Abstract).

Claims 34, 78, 122: Conklin et al. teaches:

- finding contact information for one or more matchmakers from a directory service (col. 17 lines 14-34) as inferred by the use of the Internet by the matchmaker; and
- requesting and receiving from at least one matchmaker a vendor information for a particular category of products (col. 13 lines 12-41).

Claims 35, 79, 123: Conklin et al. teaches the vendor information includes contact information for each vendor (fig. 9 [605, 610, 615]).

Claims 36, 80, 124: Conklin et al. teaches requesting a quote from one or more vendors on the list of vendors (col. 20 lines 24-34).

Claims 37, 81, 125: Conklin et al. teaches completing a purchase for a product with a selected one of the vendors supplying a quote for the product (col. 19 line 14 – col. 24 line 41).

Claims 38, 82, 126: Conklin et al. teaches the list of vendors for a particular category of products requested by the consumer agent is selected after a search of available product categories from the matchmaker (col. 32 lines 8-16).

Claims 39, 83, 127 Conklin et al. teaches the list of vendors for a particular category of products requested by the consumer agent is selected after browsing a listing of categories available from the matchmaker (col. 32 lines 8-16).

Claims 40, 84, 128: Conklin et al. teaches the list of vendors for a particular category of products requested by the consumer agent is selected using at least one keyword search term (fig. 29 [SO1, SO3, SO6]).

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Claims 41, 85, 129: Conklin et al. teaches the list of vendors for a particular category of products requested by the consumer agent is selected based on a similarity to a selected listing (fig. 29 [SO1, SO3, SO6]).

Claims 42, 86, 130: Conklin et al. teaches:

- identifying a matchmaker using at least one of a plurality of directory services containing contact information for one or more matchmakers, wherein at least one directory service contains a different set of matchmakers from at least one other directory service (Abstract; col. 10 lines 23-33);
- contacting the matchmaker and obtaining advertisement content and format requirements (col. 20 lines 5-23);
- creating an advertisement complying with advertisement content and format requirements for the matchmaker (col. 20 lines 5-23); and
- providing the advertisement to the matchmaker (col. 20 lines 5-23).

Claims 43, 87, 131: Conklin et al. teaches providing the matchmaker with a preferred presentation of the advertisement (col. 20 lines 5-23), in the context of as uploading product catalogs, customizing the Website from time to time, and similar processing.

Claims 44, 88, 132: Conklin et al. teaches the preferred presentation of the advertisement comprises a preferred placement of the advertisement in a list of advertisements provided to consumer agents (col. 22 line 40 – col. 23 line 9).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 14, 28, 58, 72, 102, and 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al., as applied to claims 9, 53 and 97 above, and further in view of Official Notice.

Claims 14, 58, 102: Conklin et al. does not explicitly teach the available products include services. However, Official Notice is taken that it was old and well known in the art at the time the invention was made that products for sale includes services from sellers, e.g., delivery services, maintenance services, information

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services, and others. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Conklin et al. to explicitly teach the available products include services, as taught by old and well known art, for the motivation of matching consumers with vendors for the sell of services to buyers.

Claims 28, 72, 116: Conklin et al. does not explicitly teach the advertisements are carried for a limited time. However, Official Notice is taken that it was old and well known in the art at the time the invention was made that advertisements generally have an active lifetime for presentation to users. Advertisements become old and/or obsolete over time due to, e.g., changing business priorities and conditions. What may have been a current offer yesterday may be void tomorrow due to changing business conditions, e.g., the advertised product is sold out. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Conklin et al. to explicitly teach the advertisements are carried for a limited time, as taught by old and well known art, for the motivation of matching consumers with vendors for the sell of products to buyers and influencing buyers to make purchases

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art includes:

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- Alberts (U.S. Patent no. 5,937,392) that teaches an Internet advertising system having a database, a controller, and an ad server operating as part of a web server.

The database has advertising campaign information, including identification information and frequency information for how often the ad is to be served. The ad server uses the campaign information from the database to control the relative ratios of serving ads, the distribution of ads throughout the day, and any triggering mechanisms for controlling what ads are served.

- Thorner et al. (U.S. Patent No. 6,463,443) that teaches, for directory services for telecommunication, a data network, a terminal connected to the data network, at least one database in the data network, and a device for interactive communication between the terminal and the network regarding the database are provided. The database includes catalogue data regarding subject information about persons/families/companies, so that catalogue searches using different search criteria can be done. The desired information and adequate search criteria may be asked for from the terminal. The search is performed, and the desired catalogue data is presented visually on a display of the terminal asking for the subject information.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT

06/16/2004


Jeffrey A. Smith
Primary Examiner